

## ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. chen da shuai  
Case No. D2024-0917

### 1. The Parties

The Complainant is LEGO Juris A/S, Denmark, represented by CSC Digital Brand Services Group AB, Sweden.

The Respondent is chen da shuai, China.

### 2. The Domain Name and Registrar

The disputed domain name <lego-mall.shop> is registered with Gname.com Pte. Ltd. (the "Registrar").

### 3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on March 1, 2024. On March 1, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 4, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Guangdong) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 4, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint in English on March 6, 2024.

On March 4, 2024, the Center informed the Parties in Chinese and English, that the language of the Registration Agreement for the disputed domain name is Chinese. On March 6, 2024, the Complainant requested English to be the language of the proceeding. The Respondent did not submit any comment on the Complainant's submission.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent in English and Chinese of the Complaint, and the proceedings commenced on March 12, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 1, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 2, 2024.

The Center appointed Deanna Wong Wai Man as the sole panelist in this matter on April 8, 2024. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

#### **4. Factual Background**

The Complainant is the owner of the famous LEGO-branded construction toys and other LEGO-branded products. The Complainant's licensees are authorized to exploit the Complainant's intellectual property rights, including its trademark rights, in China and elsewhere. Over the years, the Complainant's business of making and selling LEGO branded toys has grown remarkably. The Complainant has subsidiaries and branches throughout the world, and LEGO products are sold in more than 130 countries, including in China, the jurisdiction where the Respondent is located. The Complainant's products and brands have received worldwide recognition and accolades, for example, the Reputation Institute recognized the LEGO Group as number 1 on its list of the world's Top 10 Most Reputable Global Companies of 2020.

The Complainant has a large international trademark portfolio for the LEGO marks in different jurisdictions, including Japanese Trademark Registration No. 520470, registered on May 21, 1958; and Chinese Trademark Registration No. 75682, registered on December 22, 1976. The Complainant also has a strong online presence and is the owner of close to 5,000 domain names containing the mark LEGO.

The disputed domain name was registered on December 9, 2023, and is therefore of a later date than the abovementioned trademarks of the Complainant. The Complainant submits evidence that the disputed domain name previously directed to an active website, prominently featuring the Complainant's logo in connection with a purported login portal that requested users to fill in their email address and password information, and also offered an option to login via mobile number. However, the Panel notes that on the date of this Decision, the disputed domain name directs to an inactive/error page.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name is confusingly similar to its famous registered trademarks as it incorporates the LEGO mark entirely. The Complainant also states that the Respondent has no rights or legitimate interests in respect of the disputed domain name: the Respondent is not a licensee of the Complainant, and the Complainant has not given the Respondent any permission to register the trademark as a domain name, nor is there any evidence that the Respondent has been commonly known by the disputed domain name, the Respondent has not used, or prepared to use, the disputed domain name in connection with a bona fide offering of goods and/or services or for any legitimate noncommercial or fair purpose. Furthermore, the Complainant argues that the Respondent uses the disputed domain name to host a website, prominently featuring the Complainant's logo in connection with a login portal that requests users to fill in their email address and password information. There is also an option to login via mobile number. The Complainant deduces from this that the website at which the disputed domain name resolves seeks to take advantage of the fame of the Complainant's trademarks and the trust and goodwill that the Complainant has fostered among consumers to, at minimum, illegitimately increase

traffic to the Respondent's website for personal gain, and at worst, "phish" personal information from the Complainant's customers (in the event that the Respondent seeks to obtain visitors' personal information as part of a larger scheme to perpetrate fraud by exploiting the fraudulently acquired personal information to, perhaps, acquire sensitive financial information). The Complainant essentially argues that such use of the disputed domain name does not confer rights or legitimate interests on the Respondent and constitutes registration and use in bad faith of the disputed domain name.

The Complainant finally also states that the Respondent did not respond to the cease-and-desist letter sent regarding the disputed domain name.

## **B. Respondent**

The Respondent did not reply to the Complainant's contentions.

## **6. Discussion and Findings**

### **6.1 Preliminary Issue: Language of the Proceeding**

The language of the Registration Agreement for the disputed domain name is Chinese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the fact that the Complainant states that it is unable to communicate in Chinese and translation of the Complaint would unfairly disadvantage and burden the Complainant and delay the proceedings and adjudication of this matter; the fact that additional delay poses continuing risk to the Complainant and unsuspecting consumers seeking the Complainant or its products; the fact that the disputed domain name is comprised of Latin characters; the fact that the website found at the disputed domain name featured various phrases in English including "Email login" and "Remember & auto-login"; and the fact that the term "lego", which is the dominant portion of the disputed domain name, does not carry any specific meaning in the Chinese language.

The Respondent did not make any submissions with respect to the language of the proceeding.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time, and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1).

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

### **6.2 Substantive Issue**

#### **A. Identical or Confusingly Similar**

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the Complainant's mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms here, "-mall" may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

## **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Moreover, upon review of the facts and evidence, the Panel notes that the Respondent has not provided any evidence of the use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services. Instead, upon review of the facts and the evidence submitted in this proceeding, the Panel notes that the disputed domain name previously directed to an active website, prominently featuring the Complainant's logo in connection with a purported login portal that requests users to fill in their email address and password information, and also offered an option to login via mobile number. This suggests that the Respondent may have been using the disputed domain name to mislead Internet users by creating a misleading affiliation with the Complainant thereby driving Internet traffic to the website linked to the disputed domain name and creating a grave risk that the Respondent may have been using it for potential phishing and spamming activities. Such activities do not confer rights or legitimate interests on the Respondent, see in this regard also previous UDRP decisions such as *Accenture Global Services Limited v. Leed Johnny (蒋黎)*, WIPO Case No. [D2020-0578](#). Given the abovementioned elements, the Panel concludes that the Respondent's use of the disputed domain name does not constitute a bona fide offering of goods or services, nor a legitimate noncommercial or fair use of the disputed domain name.

Furthermore, the Panel notes that the disputed domain name currently directs to an inactive, error webpage. In this regard, the Panel finds that holding a domain name passively, without making any use of it, does not confer any rights or legitimate interests in the disputed domain name on the Respondent (see in this regard earlier UDRP decisions such as *Bollore SE v. 赵竹飞 (Zhao Zhu Fei)*, WIPO Case No. [D2020-0691](#); and *Vente-Privee.Com and Vente-Privee.com IP S.à.r.l. v. 崔郡 (jun cui)*, WIPO Case No. [D2021-1685](#)).

Finally, the Panel finds that the nature of the disputed domain name, being confusingly similar to the Complainant's famous trademarks and containing the term "-mall", carries a risk of implied affiliation and

cannot constitute fair use, as it effectively impersonates the Complainant and its products or suggests sponsorship or endorsement by the Complainant (see [WIPO Overview 3.0](#), section 2.5.1).

Based on the available record, the Panel finds the second element of the Policy has been established.

### **C. Registered and Used in Bad Faith**

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent has registered a domain name which is confusingly similar to the Complainant's well known, intensely used, and distinctive trademarks for LEGO. The Panel refers to many prior decisions under the Policy which have recognized the well known nature of these trademarks, see for instance *LEGO Juris A/S v. Level 5 Corp.*, WIPO Case No. [D2008-1692](#). The Panel deduces from this fact that by registering the disputed domain name, the Respondent deliberately and consciously targeted the Complainant's prior well known trademarks for LEGO. The Panel finds that this creates a presumption of bad faith. In this regard, the Panel refers to the [WIPO Overview 3.0](#), section 3.1.4, which states "[p]anelists have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith." Furthermore, the Panel also notes that the Complainant's trademarks were registered many years before the registration date of the disputed domain name. The Panel deduces from these elements that the Respondent knew, or at least should have known, of the existence of the Complainant's trademarks at the time of registering the disputed domain name. In the Panel's view, these elements indicate bad faith on the part of the Respondent, and the Panel therefore finds that it has been demonstrated that the Respondent registered the disputed domain name in bad faith.

As to use in bad faith, the Panel notes that the disputed domain name previously directed to an active website, prominently featuring the Complainant's logo in connection with a purported login portal that requests users to fill in their email address and password information, and also offered an option to login via mobile number. This suggests that the Respondent may have been using the disputed domain name to mislead Internet users and create a grave risk that the Respondent may have been using it for potential phishing and spamming activities. The Panel accepts that this means that the Respondent was using the disputed domain name in bad faith, see in this regard also previous UDRP decisions such as *Accenture Global Services Limited v. Leed Johnny (蒋黎)*, WIPO Case No. [D2020-0578](#).

However, on the date of this Decision, the disputed domain name directs to an inactive/error page. Panels have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds that the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness and exceptionally strong international reputation of the Complainant's trademarks, the fact that the Respondent ignored the Complainant's cease-and-desist letter and also did not file any response in this procedure, the composition of the disputed domain name including the Complainant's famous trademarks entirely, the Respondent's bad faith use of the disputed domain name prior to the date of this Decision and the unlikelihood of any future good faith use of the disputed domain name by the Respondent and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

Based on the available record, the Panel finds that the Complainant has established the third element of the Policy.

## **7. Decision**

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <lego-mall.shop> be transferred to the Complainant.

*/Deanna Wong Wai Man/*

**Deanna Wong Wai Man**

Sole Panelist

Date: April 16, 2024